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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/966,033 | 09/28/2001 | Joshua R. Smith | 103140-0012U1 | 7207 |
| 24267 7590 06/23/2009 CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210 | | | | |
| EXAMINER PLUCINSKI, JAMISUE A | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3629 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/966,033

Applicant(s)

SMITH ET AL.

Examiner

JAMISUE A. PLUCINSKI

Art Unit

3629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 7, 9-11, 13, 20-26, 28-30, 32 and 34-47 is/are pending in the application.
- 4a) Of the above claim(s) 3, 7, 9-11, 13, 20, 25, 26, 32 and 34-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 21-24 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/6/09 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 4, 21-24 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilibin et al. (US 2005/0197892) in view of Guidice et al. (6,463,420) and Kanevsky et al. (6,285,777).

4. With respect to Claims 2, 4, 20-323 and 28-30: Bilibin discloses the use of a method comprising the steps:

- a. Associating respective users with user identifiers (Paragraph 162, registering and creating user ID and passwords);
- b. Associating with the respective users mail pieces directed by others, different carriers, to respective users sent to others by the respective users (Figures 56 and 57 with

corresponding detailed description, the examiner notes who the mail piece is sent to does not patentably distinguish itself from the prior art, the tracking would be processed the same regardless of the recipient, therefore considered to be non-functional descriptive material);

c. Linking to the user identifiers to which the mail pieces are associated mail piece delivery status information relating to the respective mail pieces (Figure 50, Reference numerals 441-442 with corresponding detailed description);

d. Receiving information concerning the contents of the respective mail pieces from the senders of the respective mail pieces and linking to the delivery status information an attachment consisting of the information concerning the contents of the respective mail pieces (Figures 51-54 with corresponding detailed description). However, the specific type of information (i.e. text information, graphics audio file) is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The providing and display steps would be performed the same regardless of the noises or pictures presented. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

e. Providing a graphical interface configured for entering user identifiers and providing access (Paragraph 147 and Figure 54 Reference numeral 1258 with corresponding detailed description) to:

- i. Producing on the users personal webpage a respective listing of the delivery status information directed to the respective users (See Figure 76, Bilibin discloses a shipping log of inbound and outbound packages for the user, therefore the examiner considers this a users personal webpage);
 - ii. Provide the mail piece delivery status information that is linked to the user identifiers that are associated with the respective users, and
 - iii. Provide to the respective users the associated information concerning the contents of the respective mail pieces (See Figures 71-72 with corresponding detailed description).
 - iv. Including links to the respective messages in the listing of the delivery status information, which allows a user to perform sending and receiving a message (Figure 72 with corresponding detailed description, which allows a user to receive a message when delivered).
 - f. Bilibin discloses that everything that is done, is done through a webpage, where a user signs in and can view transaction history as well as shipping logs, the examiner considers this to be a personal webpage, due to the fact that a user has to sign in to access all their information, which is stored in the server (See Figure 76 with corresponding detailed description).
5. Bilibin discloses linking the user identifiers to the mail pieces, however fails to teach linking the mail piece delivery status with the user identifier. Guidice teaches the system identifying if the submitted orders that can be tracked according to the user ID (Column 6, lines 45-60). It would have been obvious to one having ordinary skill in the art at the time the

invention was made, to combine the associated steps of Guidice with the multi-carrier tracking of Bilibin. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

6. Bilibin also fails to teach the user accessing the above information by entering user identifiers. Guidice teaches the user entering the ID and password in order to be able to select the order for which the user wishes to track (Column 6, line 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the accessing steps of Guidice with the multi-carrier tracking of Bilibin. The claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately and one of ordinary skill in the art would have recognized that the results of the combination were predictable (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

7. Bilibin and Guidice discloses the use of tracking information according to users, however fails to teach acquiring information from one or more mail piece sources, postal services or delivery companies and creating a digital shadow for each mail piece and linking the shadow to the user identifier. Knevsky discloses the use of internet assisted mail piece tracking, where a paper mail is received at the post office. The post office scans the paper mail, then forwards the scanned information data to the user/e-mail address or to the local post office (See abstract). The

examiner considers this to be a digital shadow of the mail piece, which is associated with the user, address or e-mail address and the users mail database (See Figure 2 with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Bilibin and Guidice to include the digital shadowing of Kanevsky in order to allow the user to choose how they want to receive mail and for speeding up surface mail (See Kanevsky, Columns 1 and 2).

8. With respect to Claims 24: Bilibin discloses the use of one or more messages being provided by the sender associated with the mail piece (See Figure 51 with corresponding detailed description)

Response to Arguments

9. Applicant's arguments filed 4/6/09 have been fully considered but they moot in view of the new rejection as outlined above.

10. It should be noted that the digital shadow, where as it is captured, it is never really linked to the user ID or even positively claimed as being accessed using the webpage of the status information. Further it should be noted, that the digital shadow, if given the broadest reasonable interpretation, can be digital information, and does not necessarily have to be some form of an image of the item, which appears in the current drawings. Especially due to the fact that information is acquired from the mail piece sources then a digital shadow is created.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-F (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629